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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/378,217      | 08/19/1999  | JEFFRY JOVAN PHILYAW | PHLY-24.707         | 8857             |

25883            7590            05/20/2003  
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| EXAMINER |
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NGUYEN, CHAU T

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 2142     |              |

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/378,217             | PHILYAW ET AL.      |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Chau Nguyen            | 2142                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 04 March 2003.

2a) This action is FINAL.                  2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-10 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-10 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

|   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>10</u> . | 6) <input type="checkbox"/> Other: _____                                     |

## **DETAILED ACTION**

1. Amendment B, received on 0304/2003, has been entered. Claims 1-10 are presented for examination.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1 and 6 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

4. In the specification, Applicant discloses "an advertiser is allowed the ability to control a user's PC 112 through the use of tones embedded within a program audio signal" (page 12, lines 19-20). Applicant also discloses "this routing information 904 is in the form of an embedded code within the audio signal" (col. 22, lines 6-7). However,

Applicant amended claims 1 and 6 such as "embedding a unique code, which does not contain routing information", which contradicts with the information that Applicant provided in pages 12 and 22. Therefore, Examiner considers claims 1 and 6 contain new subject matter, which was not described in the specification.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 4-5, 6, and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bendinelli et al., U.S. Patent No. 6,061,719 and further in view of Ullman et al., U.S. Patent No. 6,018,768.

7. As to claim 1, Bendinelli et al. (Bendinelli) discloses the invention substantially as claimed.

the unique code in close association with vendor information (col. 2, line 51 – col. 3, line 12 and col. 3, line 57 – col. 4, line 13: teaches a URL or other type of network information identifier which identifies a web site (vendor information));

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extracting the unique code with an extractor during output of the recorded information to a user at a user location disposed on a network (col. 3, line 13 – col. 4, line 13 and col. 5, line 57 – col. 6, line 11: teaches a decoder extracts and embedded URL or other type of network information identifier from a closed caption stream (output information) and delivers it to a computer via a suitable connection (network));

in response to extracting the unique code, transmitting the unique code to a remote location on the network in accordance with routing information accessible at the user location, wherein the vendor information is returned to the user location for processing (col. 2, line 51 – col. 3, line 12 and col. 5, line 57 – col. 6, line 11: teaches from extracting the URL or other network information identifier (unique code) identifying a web site at a server (remote location) and wherein a web page (vendor information) is delivered to the computer for display).

However, Bendinelli does not explicitly disclose the unique code in recorded information of the compact disk, and the unique code will be output during normal playback of the compact disk and within the video/audio bandwidth thereof. Ullman et al. (Ullman) discloses on col. 5, lines 28-30, col. 9, lines 4-35, and col. 10, lines 4-25: teaches operating a DVD player at a user site to read a video program with embedded URLs (unique code) which is stored or recorded in a digital video disk and video program is displayed on the user site. Ullman also discloses the URLs (unique codes) identifying the Web site and time stamps are sent automatically to the desktop of each student either during playback of a pre-recorded program or during a live event (col.10, lines 33-49). Since Ullman discloses a system for integrating video programming with

the information resources of the Internet, which is similar to synchronized presentation of television programming and web content of Bendinelli, It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a digital video disk (DVD) storing video program with embedded URLs and DVD player to retrieve video program to display on user site and the URLs (unique codes) identifying the Web site and time stamps are sent automatically to the desktop of each student either during playback of a pre-recorded program or during a live event as taught by Ullman, and extract a unique code to identify the location of a server corresponding that unique code, as taught by Bendinelli, in a digital computing environment. The motivation to do so would have been to provide a user friendly environment by giving customers additional information automatically through the Internet.

8. As to claim 4, Bendinelli and Ullman (Bendinelli-Ullman) disclose the network is a global communication network that provides a universal resource locator (URL) for each location on the network and the routing information is comprised of the URL for the location (Bendinelli, col. 2, line 51 – col. 3, line 12).

9. As to claim 5, Bendinelli-Ullman disclose the unique code is an audible tone.(Bendinelli, col. 2, line 51 – col. 4, line 13: teaches network information identifier can be embedded in any other type of signal).

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10. Claims 2-3 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bendinelli-Ullman as applied to claims 1 and 4-5 above, and further in view of Hitzelberger, U.S. Patent No. 6,061,368.

11. As to claim 2, Bendinelli-Ullman disclose the invention substantially as claimed as described supra. However, Bendinelli-Ullman do not explicitly teach an intermediate location on the network for comparing the received unique code with the stored vendor routing information in the database. Hitzelberger discloses on col. 4, lines 9-56: a routing engine (intermediate location) for matching source identifiers with the destination identifiers from a cache (stored vendor routing information) in the routing engine. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a routing engine (intermediate location), as taught by Hitzelberger, to identify a web site at server using a code, as taught by Bendinelli-Ullman, in a network environment. The motivation to do so would have been to provide a routing engine to match the source identifier with the destination identifiers stored in the cache to be able to identify the web page (vendor information) at a server for interconnection increasing the reliability in establishing connection between source and destination.

12. As to claim 3, Bendinelli-Ullman and Hitzelberger (Bendinelli-Ullman-Hitzelberger) disclose the user location further includes user ID information that

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uniquely identifies the user location (Hitzelberger, col. 4, line 9-56: teaches a source identifier), and

wherein the database at the intermediate node includes user profiles information which is associated therein with the user ID information of the user location (Ullman, col. 3, line 44 – col. 4, line 4), and

wherein the step of transmitting the unique code over the network to the intermediate note also includes transmitting the user ID information to the intermediate location, and the step of matching further comprises matching the received user ID information of the user location with stored profile information associated with the received user ID information (Hitzelberger, col. 4, line 9-56: teaches routing engine (intermediate note) which includes identifier, and a matching function for comparing source identifier with a destination identifiers stored in cache to be encoded in a packet that is transmitted to the destination), and

wherein the step of transmitting the matching vendor routing information back to the user location further includes appending to the vendor routing information the stored profile information, and wherein the stored profile information is transmitted to the remote vendor information location via the user location (Hitzelberger, col. 4, line 9-56).

13. Claims 6-10 have similar limitations as discussed in the method of claims 1-5; therefore, they are rejected under the same rationale.

***Response to Arguments***

14. In the remarks, Applicant argued in the substance that

(A) Prior art does not disclose “a unique code, which does not contain routing information”

As to point (A), please see the above rejection (***Claim Rejections - 35 USC § 112***)

(B) Prior art does not disclose “transmitting the unique code to a remote location on the network in accordance with routing information stored at the user location”

As to point (B), Bendinelli teaches a decoder 52 receives television signal, extracts and embedded URL, and delivers it to a computer 54, and from extracting the URL or other network information identifier (unique code) identifying a web site at a server (remote location) and wherein a web page (vendor information) is delivered to the computer for display (col. 2, line 51 – col. 3, line 12 and col. 5, line 57 – col. 6, line 11).

(C) Prior art does not disclose “routing information stored at the user location”

As to point (C), Bendinelli teaches the computer 54 runs a web browser program which uses the extracted URL from the decoder 52 to establish a connection with server

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42, and the server 42 delivers a web page specified by the extracted URL to the computer 54 and the web page is displayed on the computer 54) (col. 2, line 51 – col. 3, line 12 and col. 5, line 57 – col. 6, line 11).

(D) Prior art does not disclose “transmit matching vendor routine information back to the end user location”

As to point (D), Hitzelberger discloses on col. 4, lines 9-56: a routing engine (intermediate location) for matching source identifiers with the destination identifiers from a cache (stored vendor routing information) in the routing engine. Bendinelli discloses based on the extracted URL from embedded URL in the television signal, the server 42 delivers a web page to the computer 54.

(E) Prior art does not teach the user profile information content stored on the database at the intermediate location

As to point (E), Hitzelberger, col. 4, line 9-56: teaches routing engine (intermediate note) which includes identifier, and a matching function for comparing source identifier with a destination identifiers stored in cache to be encoded in a packet that is transmitted to the destination. Ullman discloses sending a different stream of URLs to each user depending on a unique user profile (col. 3, line 44 – col. 4, line 4).

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**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau Nguyen whose telephone number is (703) 305-4639. The examiner can normally be reached at 8:00 am – 5:00 pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Powell can be reached on (703) 305-9703. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3230.

Any response to this final action should be mailed to:

**Box AF**

Commissioner of Patents and Trademarks  
Washington, D.C. 20131

**Or Faxed to:**

(703) 746-7239, (for **formal communications**; please mark  
“EXPEDITE PROCEDURE”).

**Or:**

(703) 746-7240 (for **informal or draft communications**, please label  
“PROPOSED” or “DRAFT”).

**Or:**

(703) 746-7238 (for **After Final Communications**).

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Chau Nguyen  
Patent Examiner  
Art Unit 2142

  
MARK R. POWELL  
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